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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/512,669	02/24/2000	Ulrike Jeck-Prosch	32140-153023	5754
26694	7590	02/15/2005	EXAMINER	
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			CLEVELAND, MICHAEL B	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/512,669

Applicant(s)

JECK-PROSCH ET AL.

Examiner

Michael Cleveland

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 43, 50, 51 and 60-64.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


Michael Cleveland
Primary Examiner
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Response to Amendment

1. The proposed After Final amendment will not be entered because it raises new issues for further search and consideration, such as evaluation of the new limitation regarding the reduction of temperature gradient of a propellant charge during combustion under 35 USC 112, 1st paragraph for scope of enablement, 35 USC 112, 2nd paragraph for clarity, and 35 USC 102/103 compared to the prior art.

Response to Arguments

2. Applicant's arguments filed 1/26/2005 have been fully considered but they are not persuasive.

Applicant requests withdrawal of the finality of the prior Office Action because Boileau and Haaland were newly cited. The argument is unconvincing because Boileau and Haaland were cited in response to new claims 60-63. Applicant implies that the amendment should reasonably have expected to be claimed. The argument is unconvincing because Applicant fails to demonstrate why the new limitations of claims 60-63 should have been expected to be claimed, particularly given that Applicant has never argued or claimed these features throughout the extensive prosecution of the case. Accordingly, the finality of the final rejection is maintained.

Applicant argues the limitation regarding the reduction of a temperature gradient for a propellant charge has been at issue for some time. The argument is unconvincing because no claim with the feature has been presented, and because Applicant's prior arguments do not emphasize the feature. Applicant presents comments from the March 3, 2004. However, these arguments appear merely in Applicant's summary of the invention. (The Examiner notes that Applicant's first quotation is taken wholly from Applicant's second quotation, so that rather than emphasis, the second quotation merely serves as repetition.) Applicant does not argue that the feature of the reduction of a temperature gradient for a propellant charge is what renders the claims patentable. In fact, Applicant's specific arguments regarding the rejections are silent as to this feature. Furthermore, the quoted section does not emphasize reduction of a temperature gradient alone, but reduction of both temperature and pressure gradients at low and normal temperatures. Accordingly, the currently claimed feature has not been discussed or emphasized as a reason for patentability.

Applicant argues that the Examiner has equated “surface treating” or “surface coating” with “mixing”. The argument is unconvincing because it is the Examiner’s position that the terms “surface treating” and “surface coating” are broader than the term “mixing”. As stated in the prior action, any act of dispersing a solid material within another material or mixing a solid material with another material necessarily involves action of the other material on the solid material at the surface of the solid material. Therefore, “dispersing” and “mixing” in the sense described by the cited references necessarily meets the limitation of “surface treating”. O’Meara also teaches “surface coating” because it contains particles (16) dispersed within (and therefore coated by) particulate (10) (See Fig. 1).

Applicant argues that they do not understand the argument because cellulose ester is mentioned. The mention of cellulose ester is an artifact of previous rejections, but is extraneous to any current claims. However, cellulose ester is not excluded by the claims.

Applicant’s arguments that the previous response dealt only with the word “treat” and not with “surface” is unconvincing because the prior action explicitly defined “treat” and then clearly explained how the prior art meets the limitation by performing the function of treating on the surface of the powder. The prior action is quoted here, with emphasis to the phrase “at the surface” added: “They are unconvincing because “treat” means “to act upon with some agent esp. to improve or alter” (*Merriam-Webster’s Collegiate Dictionary*, 10th edn.). Any act of dispersing a solid material within another material or mixing a solid material with another material necessarily involves action of the other material on the solid material at the surface of the solid material. Therefore, “dispersing” and “mixing” in the sense described by the cited references necessarily meets the limitation of “surface treating”.

In response to applicant’s argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., that the coating is not in the form of a mixture) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant’s arguments against the references O’Meara and Lutz individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

O'Meara teaches surface treatment of powders with nitroglycerine to form a propellant, and Lutz teaches that alkyl NENAs are superior to nitroglycerine.

Applicant argues that Boileau relates only to propellant charges for small and medium caliber ammunition without cartridge cases and that it compresses the charges in a pressing operation. The argument is unconvincing because such features are not excluded by the claims. Applicant's arguments that '837 does not relate to the combustion behavior of coated propellant grains is unconvincing because Applicant's claims do not relate to the combustion behavior of coated propellant grains, but only to a method of producing a layered propellant. Boileau teaches a method of coating a propellant.

Applicant's arguments regarding the particulars of Haaland are unconvincing because Haaland is cited merely for its teaching of an energetic, thermoplastic polymer, which is called for by the disclosure of Boileau. The selection of something based on its known suitability for its intended use has been held to support a *prima facie* case of obviousness. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

Applicant's arguments that Haaland does not teach the energetic material as a combustion moderator are unconvincing because such feature is not claimed and further because the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's arguments against the references Boileau and Haaland individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). O'Meara teaches surface treatment with nitroglycerine to form a propellant, and Lutz teaches that alkyl NENAs are superior to nitroglycerine.

Applicant's arguments regarding "mixing" and "dispersing" are unconvincing regarding Boileau because it explicitly teaches "coating".

Applicant's arguments on p. 12-13 regarding statements to the EPO are unconvincing because they are unsupported by a showing of evidence and because they do not present


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arguments regarding the documents under consideration in the present case. (It is unclear to which documents they do refer.) Furthermore, they do not represent a comparison to the closest prior art, Boileau, which teaches the use of dinitropolystyrene.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Cleveland whose telephone number is (571) 272-1418. The examiner can normally be reached on Monday-Thursday, 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Cleveland
Primary Examiner
Art Unit 1762

2/14/2005